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10/014,868	12/14/2001	Shih-Ming Huang		1779

7590 09/24/2003  
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EXAMINER

KLEBE, GERALD B

ART UNIT PAPER NUMBER

3618

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/014,868

Applicant(s)

HUANG, SHIH-MING

Examiner

Gerald B. Klebe

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-7, 11 and 12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Restriction / Election*

1. Applicant's response filed 7/15/2003 to the restriction requirement of the Office action mailed 6/16/2003 elected, with traverse the species I, related to Figures 2-4, further identifying claim 1 as reading thereon. The traversal of the restriction requirement, being without argument, is not persuasive and therefore the restriction requirement is maintained and hereby made final. The examiner agrees with Applicant's identification of claim 1 as reading on the elected species; however, the examiner further identifies claims 2-7 and 11-12 as also readable on the elected species I, Figures 2-4. Claims 8-10 are held by the examiner as reading on the non-elected species. As stated in the earlier Office action, upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP Se. 809.02(a). At present, there appears to be no allowable generic claim, therefore, claims 8-10 are hereby withdrawn from further consideration.

### *Drawings*

2. The drawings are objected to for the following informalities:

Figure 1 should be identified in the body of the figure as "Prior Art".

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the use of two(2) resilient members arranged between the coupling stage and the swing members as recited in claim 1, at lines 6-7 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Appropriate correction is required.

***Claims Objections***

3. Claims 11-12 are objected-to as not being in appropriate sequence. Claims 11 and 12 each depend from independent claim 1 but are separated numerically by the intervening independent claim 6. A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

However, a claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

***Claims Rejections - - 35 USC Sec. 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-5, and 11-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites the limitation "...at least two resilient members arranged between the coupling stage and the swing members..." in lines 6-7. The figures 2-4 depicting the elected species show only one resilient member being used between the coupling stage and the swing member of the skateboard. The use of two(2) resilient members arranged between the coupling stage of the skateboard platform and the swing members is not supported by the specification including the figures for the elected species.

Appropriate clarification or correction is required. No new matter may be entered.

***Claims Rejections – 35 U.S.C. Section 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Agajanian (US 4123080).

Agajanian discloses a skateboard (10) with vibration-absorbing function, comprising: (re: **claim 1**) a platform (12); a coupling stage formed on a bottom center of the platform (refer fig 3); two swing members connected to the coupling stage (taken as the left and right ends, 58 and 60, of element 54; refer Fig 3); at least two resilient members (62; refer col 3, lines 21-23) arranged between the coupling stage and the swing members; at least two wheels, each arranged below the swing member and corresponding to the resilient member and wherein (re: **claim 3**) the swing member has a retaining rod (Fig 3, item 56) extended toward the coupling stage and clamped by a confining section ( taken as the hole provided for item 56) in the coupling stage.

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8. Claims 1-4, 6-7, and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Muhammad (US 4230330).

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Muhammad discloses a skateboard with vibration-absorbing function, comprising: (re: **claims 1 and 6**) a platform (12); a coupling stage (32) formed on a bottom center of the platform; two swing members (taken as the opposite ends of 28) connected to the coupling stage; at least two resilient members (18, at each end, including their resilient inserts 48 and 58) arranged between the coupling stage and the swing members; at least two wheels (20), each arranged below the swing member (28) and corresponding to each resilient member (18, one at each end); and wherein (re: **claims 2 and 7**) one swing member has a braking section (30, holding 22) on a rear end thereof; and wherein (re: **claim 3**) the swing member has a retaining rod (66) extended toward the coupling stage and clamped by a confining section arranged in the coupling stage; and wherein (re: **claim 4**) a plurality of supporters (24; refer col 2, lines 35-38) <sup>with fasteners that are</sup> are embedded into the platform; and wherein (re: **claim 12**) the braking section is a base (the not separately numbered part of 30 holding 22) with a rotor (68).

*Claims Rejections – 35 USC Sec. 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Muhammed (US 4230330).

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As discussed above, Muhammed discloses all of features of the invention, except that Muhammed lacks explicit teaching wherein the resilient member is covered with a flexible dust cover; and wherein the resilient member is an air sac.

However, regarding the features of claim 5 wherein the resilient member is covered with a dust cover, the examiner takes Official Notice that it is old and well-known in the skateboard arts to provide covers for the resilient members of the wheel suspension elements when it is foreseen that the resilient members would be adversely affected by the anticipated use environment of the skateboard.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the instant invention was made to have modified the skateboard of Muhammed to have covered the resilient members with flexible covers as engineering design choices based upon anticipated environments during use of the skateboard.

Regarding the feature of claim 11, wherein the resilient member is an air sac, Muhammed discloses the claimed invention except that Muhammed uses a compression spring rather than an air sac for the resilient member. However it would have been obvious to one having ordinary skill in the art at the time the invention was made to have substituted an air sac member for the compression spring of Muhammed since the examiner takes Official notice of the equivalence of compression spring and an air sac for their use in the wheel suspension arts and the selection of any of these known equivalents to provide resilient wheel suspension for the skateboard would be within the level of ordinary skill in the art.

#### ***Prior Art made of Record***


11. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art of Brand et al. teaches a skateboard with coupling stage on the bottom center of the platform and two swing members with resilient members providing vibration-


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absorbing wheel suspensions; Mongeon teaches a roller skate assembly comprising a platform, a coupling stage on a bottom center of the platform, two swing members connected to distal ends of the coupling stage and resilient members between the coupling stage and the swing arms to resiliently support the wheels of the skate; Attey teaches a skateboard with wheel suspension from a swing arm pivotally connected to an end of the board; Grossman teaches a skateboard with wheels suspended from resiliently supported swing arms connected to a coupling stage on the bottom center of the platform of the board; Berta teaches a roller skate with wheels resiliently suspended from swing arms with resilient members and pivotally connected at the front and rear ends of the skate; Tipton teaches a skateboard with in-line wheels suspended from the board by resiliently supported swing arms; Simms teaches a wheeled ski simulator having resiliently suspended rollers between the primary wheels of the board. These references also show other features in common with some of the claimed features of the instant invention.

### *Conclusion*

12. Any inquiry concerning this or earlier communication(s) from the examiner should be directed to Gerald B. Klebe at 703-305-0578, fax 703-308-2571, M-F 8:00 AM- 4:30 PM ET, or to Supervisory Patent Examiner Brian L. Johnson, Art Unit 3618, at 703-308-0885. When faxing official correspondence please use the TC 3600 Official Rightfax numbers as follow: Regular correspondence: 703-872-9326; After Finals: 703-872-9327; Customer Service 703-872-9325.

 gbklebe / Art Unit 3618 / 16 September 2003

  
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